

Application No.: 10/676454

Case No.: 58611US002

**REMARKS**

Claims 18 to 35 are pending. Claims 1 to 17 and 36 to 44 have previously been canceled.

**§ 102 Rejections**

Claims 18-22 and 27-31 stand rejected under 35 USC § 102(c) as being anticipated by Shizuno et al. (US Patent Application Publication 2003/0088928). . "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987); MPEP § 2131.

Independent claim 18 is directed to a tape roll for removing debris from a surface to be cleaned. The tape roll comprises a plurality of tape layers and an adhesive coating consisting essentially of an elastomer and at least about 56% by weight tackifier, adhered to an outer surface of each layer (emphasis added).

Independent claim 27 is directed to a tape roll for removing debris from a surface to be cleaned. The tape roll comprises a plurality of tape layers and an adhesive coating adhered to an outer surface of each layer consisting essentially of an elastomer and at least about 56% by weight tackifier (emphasis added).

Shizuno et al. discloses an adhesive that comprises a base polymer, a tackifier, a softener and an antioxidant. (emphasis added, Shizuno et al., ¶ 55). The softener is disclosed to include process oil, mineral oil, various plasticizers, polybutene, and liquid tackifying resins. (Shizuno et al., ¶ 57). The softener is usually used in an amount of 10 to 50 parts by weight per 100 parts by weight of the total of the tackifier and the softener. (Shizuno et al., ¶ 57).

The transitional phrase consisting essentially of limits the scope of the claim to the specified materials and those that do not materially affect the basic and novel characteristics of the claimed invention. MPEP 2111.03. As stated above, the adhesive disclosed in Shizuno et al. not only includes a polymer and a tackifier, but also includes a softener such as oil or other plasticizers. Addition of a such things disclosed as a softener would affect the physical properties of the resulting adhesive. Independent claims 18 and 27 include an adhesive that consists essentially of an elastomer and a tackifier. Therefore, because Shizuno et al. also discloses that a

Application No.: 10/676454

Case No.: 58611US002

softener is required in its adhesive, Shizuno et al. does not teach or suggest the elements of the claimed invention.

Shizuno et al. does not disclose the elements of independent claims 18 and 27. Therefore, claims 18 and 27 are not anticipated by Shizuno et al. Further, claims 19-22 and 28-31 depend from claims 18 and 27, respectively, and include all of the limitations of the independent claim. Therefore, dependent claims 19-22 and 28-31 are also not anticipated by Shizuno et al. The rejection of claims 18-22 and 27-31 under 35 USC § 102(e) as being anticipated by Shizuno et al. has been overcome and should be withdrawn.

### **§ 103 Rejections**

Claims 18-22, 23-26, 27-31 and 32-35 stand rejected under 35 USC § 103(a) as being unpatentable over Shizuno et al. To establish a *prima facie* case of obviousness, the prior art references must teach or suggest all the claim limitations. MPEP §2143. As discussed above, each of independent claims 18 and 27 are directed to a tape roll where the adhesive consists essentially of an elastomer and at least about 56% by weight tackifier. Shizuno et al. only discloses an adhesive that also includes a softener. (Shizuno et al., ¶ 55). The softener includes process oil, mineral oil, various plasticizers, polybutene, and liquid tackifying resins. (Shizuno et al., ¶ 57). As stated above, inclusion of a softener would alter the properties of the resulting adhesive. Independent claims 18 and 27 include an adhesive that consists essentially of an elastomer and a tackifier. Therefore, because Shizuno et al. also discloses that a softener is required in its adhesive, Shizuno et al. does not teach or suggest the elements of the claimed invention, nor is there any teaching or suggestion in Shizuno et al. to omit the softener. As stated above, inclusion or omission of a softener alters the properties of the resulting adhesive. Shizuno et al. gave no teaching as to any particular formulation that omits the softener and that would function with their disclosed cleaner.

Because not all of the claim elements of independent claims 18 and 27 are taught or suggested by Shizuno et al., a *prima facie* case of obviousness has not been established. Further, claims 19-22 and 28-31 depend from claims 18 and 27, respectively, and include all of the limitations of the independent claim. Therefore, dependent claims 19-22 and 28-31 are also not

Application No.: 10/676454

Case No.: 58611US002

anticipated by Shizuno et al. The rejection of claims 18-22 and 27-31 under 35 USC § 103(a) as being unpatentable over Shizuno et al. has been overcome and should be withdrawn.

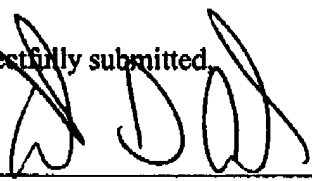
In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Respectfully submitted,

6/20/2006

Date

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